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10/099,742	03/14/2002	Olaf vancura	1482/296	4207
23381	7590	10/29/2004	EXAMINER	
DORR CARSON SLOAN & BIRNEY, PC 3010 EAST 6TH AVENUE DENVER, CO 80206			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	
DATE MAILED: 10/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/099,742

Applicant(s)

VANCURA, OLAF

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07192004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on July 19, 2004 in which applicant amends the specification, amends claims 1, 7, 9, 13, 19, 23, 25, 27, 28, and 29, cancels claim 26, submits an information disclosure statement, corrects the drawings, submits a terminal disclaimer, and responds to the claim rejections. Claims 1-25 and 26-29 are pending.

### ***Specification***

2. The disclosure is objected to because of the following informalities:
- On page 10, line 1, the examiner is unsure how the bonus feature (200) starts the random statistical frequency (300) at which the bonus feature occurs. In figure 3, the method flow diagram indicates the random statistical frequency (300) occurs prior to the hidden bonus feature (200) by virtue of the arrow pointing from flow oval (300) to flow diamond (200).

Correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8, 10-15, and 17-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Claypole et al. (G.B. 2,262,642 A).

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Claypole et al. discloses a gaming machine having a secret feature wherein the feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine. The specific combination and the existence of the secret feature are not indicated on the gaming machine panel at all. An award is provided based on a sequence of inputs made by the player in the game, however, the player need not know what sequence is required in order to obtain an award. Claypole et al. additionally discloses:

Regarding Claim 1:

- providing a hidden bonus feature (secret feature) to the player during play of the casino game, the casino game during said play not disclosing information to the player as to when the hidden bonus feature is provided and/or how the player is to respond to the hidden bonus feature, receiving a single response input (sequence of input(s) made by the player) in the casino game from the player to said provided hidden bonus feature, delivering a bonus award in the casino game to the player when the response from the player is correct (Page 16, lines 4-20).

Regarding Claim 2:

- providing the hidden bonus feature occurs when one or a predetermined combination of game symbols appears in the casino game during play of the casino game (Page 16, lines 4-20). The secret feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine.

Regarding Claim 3:

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- providing the hidden bonus feature occurs when a predetermined event (combination of symbols obtained on the reels of the gaming machine) occurs in the casino game (Page 16, lines 4-20).

Regarding Claim 4:

- providing the hidden bonus feature occurs when a hidden bonus feature display randomly occurs in the casino game (Page 16, lines 4-20). The secret feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine.

Regarding Claim 5:

- providing the hidden bonus feature occurs randomly (Page 16, lines 4-20). The secret feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine.

Regarding Claim 6:

- the existence of a hidden bonus feature is displayed on the casino game (Page 16, lines 4-20). Either a non-explanatory indicating sign appears on display screen (15) or the player realizes the hidden bonus feature has been enabled once the player is provided an award.

Regarding Claim 7:

- the bonus award is independent of the play of the casino game, thereby affording players who know how to correctly respond to said hidden bonus feature a higher expected return than players who do not know how to correctly respond to the hidden bonus feature (Page 16, lines 4-20).

Regarding Claim 8:

- the response is correct when an input is received from the player within a predetermined time period (the time period in which the gaming machine determines the sequence of inputs made by the player (Page 16, lines 4-20).

Regarding Claim 10:

- resuming play of the casino game occurs after the predetermined time frame times out (Page 16, lines 4-20). Although independent from the secret feature, the casino game continues to be played during the secret feature.

Regarding Claim 11:

- play of the casino game continues during the predetermined time frame (Page 16, lines 4-20). Although independent from the secret feature, the casino game continues to be played during the secret feature.

Regarding Claim 12:

- if the player provides a response for play of the casino game prior to providing a response for the hidden bonus feature, then the predetermined time frame immediately times out (Page 10, line 27, Page 16, lines 4-20, and Figure 1). If the player presses the collect button (18) upon entering the hidden bonus feature (secret feature), then the hidden bonus feature, as well as, game play, times out.

Regarding Claim 13:

- the casino game is a bonus game and wherein the bonus game is played in conjunction with an underlying game on a gaming machine (Page 16, lines 4-20).

Although independent from the secret feature, the casino game continues to be played during the secret feature.

Regarding Claim 14:

- the casino game is played in a gaming machine (Page 10, lines 5-27, Page 16, lines 4-20, and Figure 1).

Regarding Claim 15:

- providing the hidden bonus feature originates in a controller of a progressive system connected to the casino game (Page 9, lines 3-5).

Regarding Claim 17:

- the hidden bonus feature is an animated sequence (Page 6, line 19-Page 7, line 2 and Page 17, lines 3-4).

Regarding Claim 18:

- the hidden bonus animated sequence is a variation of animated sequences appearing in the casino game (Page 6, line 19-Page 7, line 2 and Page 17, lines 3-4).

Regarding Claim 19:

- the response from the player is the player touching the hidden bonus animated sequence appearing on a touch screen display (Page 6, line 19-Page 7, line 2, Page 8, lines 8-27, and Page 17, lines 3-4).

Regarding Claim 20:

- the hidden bonus feature is a graphic (picture or animation) (Page 6, line 19-Page 7, line 2 and Page 17, lines 3-4).

Regarding Claim 21:

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- the graphic is a variation of graphics (pictures or animations) appearing in the casino game (Page 6, line 19-Page 7, line 2 and Page 17, lines 3-4).

Regarding Claim 22:

- the player is cued as to the hidden bonus feature (Page 16, lines 4-20). Either a non-explanatory indicating sign appears on display screen (15) or the player realizes the hidden bonus feature has been enabled once the player is provided an award.

Regarding Claim 23:

- the response from the player is the player touching the hidden bonus feature appearing on a touch screen display (Page 6, line 19-Page 7, line 2, Page 8, lines 8-27, and Page 17, lines 3-4).

Regarding Claim 24:

- the hidden bonus feature is provided at the same point (when a predetermined combination of symbols is obtained on the reels) in the casino game (Page 16, lines 4-20). The secret feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine.

5. Claims 25 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (U.S. 6,113,098).

Adams discloses a gaming device which dispenses tickets (awards) which are supplemental and independent to the gaming award provided in the underlying game on the gaming machine. Adams discloses:

Regarding Claims 25 and 28:



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- providing a hidden bonus feature (supplemental award provided to player based on a number of random events dependent or independent of the inputs provided by the player) to the player during play of the casino game, without warning the player, the casino game not disclosing information to the player as to what the hidden bonus feature is and how the player responds to the hidden bonus feature, receiving a single input to the provided hidden bonus feature from the player (rate of play) within a predetermined time period after providing the hidden bonus feature, delivering a bonus award in the casino, game the play of the casino game is independent of the provided hidden bonus feature, the received input from the player and the delivered bonus award (Abstract, Column 1, lines 32-55, Column 2, line 34-Column 3, line 13, and Claims 1 and 17).

Regarding Claim 27:

- the casino game is a bonus game and wherein the bonus game is played in conjunction with an underlying gaming machine (Abstract, Column 1, lines 32-55, Column 2, line 34-Column 3, line 13, and Claims 1 and 17).

Regarding Claim 28:

- resuming play of the casino game occurs after the predetermined time frame times out (Abstract, Column 1, lines 32-55, Column 2, line 34-Column 3, line 13, and Claims 1 and 17).

Regarding Claim 29:

- the hidden bonus feature further displays a value for the award (Abstract, Column 1, lines 32-55, Column 2, line 34-Column 3, line 13, and Claims 1 and 17).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al. (G.B. 2,262,642 A).

Claypole et al. discloses to one of ordinary skill in the art that as discussed above regarding claims 1-8, 10-15, and 17-24. However, Claypole et al. seems to lack explicitly disclosing:

Regarding Claim 16:

- playing of the casino game by the player occurs over the Internet.

However, to one having ordinary skill in the art at the time of Applicant's invention, operating a gaming device over a network, whether the network is a LAN, WAN, or the Internet, was notoriously well known. One would be motivated to operate the gaming machine over a network such that a casino management system could monitor all monetary exchanges between the gaming machines and players.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al. (G.B. 2,262,642 A) in view of Walker et al. (U.S. 5,921,864).

Claypole et al. discloses to one of ordinary skill in the art that as discussed above regarding claims 1-8, 10-15, and 17-24. Furthermore, Claypole et al. discloses in one embodiment, the game offered on the screen could be a quiz/question/answer type game wherein

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the player is provided an award for answering a question correctly via the selection means (touch screen). However, Claypole et al. seems to lack explicitly disclosing:

Regarding Claim 9:

- the faster a player inputs a correct answer in the predetermined time period, the greater the bonus award.

Walker et al., like Claypole et al., teaches of an electronic game that can be played on a gaming machine (computer) wherein a player is provided an award for solving a word puzzle. Therefore, Walker et al. and Claypole et al. are analogous art. Furthermore, Walker et al. teaches:

Regarding Claim 9:

- the faster a player inputs a correct answer in the predetermined time period, the greater the bonus award (Column 2, lines 50-52 and Column 4, lines 48-56).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Walker's higher score for a faster solution feature in Claypole. One would be motivated to do so because providing a higher score (larger payout) for a correct answer provided in a shorter amount of time would add excitement to the game making the game highly entertaining to game players.

#### ***Terminal Disclaimer***

9. The terminal disclaimer filed on July 19, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Application No. 10/196,607 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Arguments***

10. Applicant's arguments, see pages 2-16 and 22-23, filed July 19, 2004, with respect to the objections to the specification have been fully considered and are persuasive with the exception noted above. The objections to the specification have been withdrawn except for the objection noted above.

11. Applicant's arguments and submission of an information disclosure statement with a copy of the listed reference, see page 22, filed July 19, 2004, with respect to the objection to the information disclosure statement has been fully considered and is persuasive. The objection to the information disclosure statement has been withdrawn.

12. Applicant's arguments, see page 22 and the corrected drawings, filed July 19, 2004, with respect to figures 1, 2, and 6 have been fully considered and are persuasive. The objection to the drawings has been withdrawn.

13. Applicant's arguments, see pages 17-21 and 23-24, filed July 19, 2004, with respect to the objections to the claims have been fully considered and are persuasive. The objection to the claims have been withdrawn. The examiner agrees with Applicant's remarks with respect to the use of the term "Internet" in claim 16, and says as much in Office Action, Paper No. 03172004 on page 5, however, the examiner made the objection to strongly urge Applicant to consider using more generic computer network terminology to claim the invention.

14. Applicant's arguments, see pages 19 and 24, filed July 19, 2004, with respect to the rejection to claims 19 and 23 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection to claims 19 and 23 under 35 U.S.C. 112, second paragraph have been withdrawn.

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15. Applicant disagrees with the rejection to claims 1-8, 10-15, and 17-29 under 35 U.S.C. 102(b) as being anticipated by Claypole et al. (G.B. 2,262,642 A). Applicant amends claims 1, 25, and 28 to allegedly overcome Claypole et al. In particular, claim 1 is amended to recite, “providing a hidden bonus feature to the player during play of the casino game, the casino game during said play not disclosing information to the player as to when the hidden bonus feature is provided and/or how the player is to respond to the hidden bonus feature,”. In Claypole et al., although the existence of the secret feature is not indicated on the machine panel at all, a non-explanatory sign, such as a light, appears on display screen (15) and would therefore tip off a very experienced player that something special was happening. However, in the alternative, Claypole et al. does not indicate what specific sequence (input) is required in order to obtain an award. Therefore, Claypole et al. anticipates claim 1.

Applicant alleges the examiner’s statement, “...the existence of the secret feature is not indicated on the gaming machine panel at all.” is incorrect. The examiner respectfully disagrees. On page 16, lines 7-10, Claypole et al. states, “These combinations, and the existence of the “secret feature” mode, are however not indicated on the machine panel at all.” Claypole et al. discloses this feature in order to detail the “secret feature” on the gaming machine. Only a very experienced player would even notice when the feature is triggered because the non-explanatory light displayed on the screen. But even then, the very experienced player would not know what specific player input(s) would be required to earn an award since this is not detailed on the machine panel.

16. Applicant amends independent claims 25 and 28 to recite, “providing a hidden bonus feature to the player during play of the casino game, without warning the player, the casino game

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having player instructions that do not disclose how the player is to respond to the hidden bonus feature,” and “randomly displaying a hidden bonus feature to the player during play of the casino bonus game without warning the player, the casino bonus game and the underlying game on the gaming machine having player instructions that do not disclose how the player is to respond to the hidden bonus feature,”, respectively which overcomes the anticipation rejection under Claypole et al. as previously stated. However, upon further consideration, a new ground(s) of rejection is made in view of Adams above.

17. Applicant disagrees with the rejections to claim 9 under 35 U.S.C. 103(a) as being unpatentable over Claypole et al. (G.B. 2,262,642 A) in view of Walker et al. (U.S. 5,921,864) and the rejection to claim 16 under 35 U.S.C. 103(a) as being unpatentable over Claypole et al. (G.B. 2,262,642 A) for the same reasons given for claim 1. However, the examiner respectfully disagrees. Please see Item No. 15 above.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- Horniak et al. '362 discloses a system and method for providing incentives to a player playing a slot machine.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (703) 308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones  
Examiner  
Art Unit 3713



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